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Paper No. 14

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In re Application of:	:	
Naum V. Gitis, et al.	:	
Application No. 09/491,284	:	DECISION ON PETITION
Filed: January 26, 2000	:	UNDER 37 CFR § 1.144
For: MAGNETIC HEAD SLIDER WITH	:	
RESISTANCE TO DEBRIS	:	
ACCUMULATION	:	

This is a decision on the petition filed December 19, 2000 under 37 CFR § 1.144 (Paper No. 10) requesting withdrawal of the restriction requirement of the Office action mailed on September 11, 2000 (Paper No. 6).

CASE HISTORY

This application was filed on January 26, 2000, with originally presented claims 1-9 and a preliminary amendment amending claims 1, 5, 8 and 9, and adding new claims 10-69.

On September 11, 2000, the examiner mailed an election of species restriction requirement to the applicant (Paper No. 6). The applicant responded on September 26, 2000 electing the claims of Group I with traverse (Paper No. 7). On December 5, 2000, the examiner made a non-final Office action (Paper No. 8) maintaining the election of species restriction requirement and making the restriction requirement Final. On September 9, 2000, applicant filed a petition under 37 CFR 1.144 requesting withdrawal of the restriction requirement.

RELIEF REQUESTED

The petition under 37 CFR § 1.144 requests the following relief:
Withdrawal of the restriction requirement.

OPINION

Applicant asserts the following in support of the position that the restriction requirement should be withdrawn:

“There must be a serious burden on the examiner if the restriction requirement is required (MPEP 803). Where the related inventions as claimed are shown to be distinct, the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; or (C) a different field of search (MPEP 808.02).”

Applicant further asserts:

“The Examiner has not even attempted to explain how examining Groups I and II would pose a serious burden (MPEP 803), much less how these Groups would involve separate classification, separate status in the art, or a different field of search (MPEP 808.02).”

Analysis:

MPEP 806.04 states in part:

“If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(C) where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.”

MPEP 806.04(f) states:

“Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.”

In the restriction requirement (Paper No. 6), the examiner restricted the claims by grouping the claims into Group I (Figures 3A-4B) and Group II (Figures 5A-6C). The basis for the restriction requirement was *patentably distinct* species.

As disclosed and claimed, both sets of species detail mutually exclusive characteristics. The species of Group I details a mutually exclusive characteristic of the overall shape of the contact pad/slider as being either V-shaped or U-shaped. The species of Group II details the overall shape of the air bearing slider as being rectangular with air bearing rail members protruding from the body of the rectangular slider. These are evidenced by the representation of the two sets of species with the set of Figures 3A-4C and 5A-6C.

Furthermore, as pointed out by the examiner in his response to applicant's traversal (Paper No.8), MPEP 808.01(a) SPECIES states:

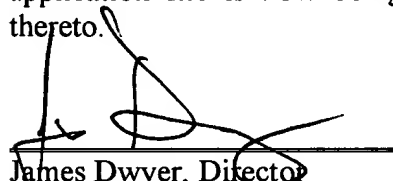
“Since claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, and it is not necessary to show a separate status in the art or separate classification.” (emphasis added)

Nonetheless, a search for one of these mutually exclusive characteristics is not coextensive with a search for the other mutually exclusive characteristics and would therefore pose a serious burden.

The examiner's holding of Finality with respect to the election of species restriction requirement in Paper No. 8 is consistent with Office policy and practice. See also MPEP 809.02(a).

Accordingly, the Petition to withdraw the restriction requirement is **DENIED**.

The amendment and response filed May 7, 2001 (Paper No. 13) have been entered. This application file is now being forwarded to the examiner for generation of a response thereto.



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